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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
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Hearing:  
April 5, 2001

Paper No. 17  
GFR

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re E\* Prescription, Inc.<sup>1</sup>

Serial No. 75/589,909

Paul E. Fahrenkopf of Barnes & Thornburg for  
E\* Prescription, Inc.

Tonja M. Gaskins, Trademark Examining Attorney, Law Office  
112 (Janice O'Lear, Managing Attorney).

Before Cissel, Hanak and Rogers, Administrative Trademark  
Judges.

Opinion by Rogers, Administrative Trademark Judge:

An application has been filed by E\* Prescription, Inc.  
to register the mark EPHYSICIAN for goods and services  
identified, following amendment, as:

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<sup>1</sup> The caption for each of applicant's briefs in this appeal identifies ePhysician, Inc. as applicant. Records of the Office's Assignment Branch, however, reveal recordation only of a grant of a security interest in the involved application, by EPHYSICIAN, Inc. to COMISCO, Inc. If applicant has assigned or otherwise transferred the involved application to EPHYSICIAN, Inc., recordation of the document(s) is recommended. See Patent and Trademark Rules in Part Three of Title 37 of the Code of Federal Regulations.

"Computer hardware and software for the online delivery of drug prescriptions and for the dissemination of patient information and drug interaction information; hand-held and desktop computers used to record, process, and transmit patient information and drug prescriptions; computer software program for use in physician practice management, including appointment scheduling, patient information, and drug information," in International Class 9; and

"Providing patient medical information, drug interaction information, and drug prescription information," in International Class 42.

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark, if used in connection with the identified goods and services, would be merely descriptive of them. When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs, and there was an oral hearing at which both applicant's counsel and the Examining Attorney appeared.

### ***The Record***

The record for this appeal consists of dictionary definitions of the "E-" prefix and of "physician"; web pages introduced by the Examining Attorney to show that use of "the prefix 'e-' means 'electronic'"; numerous excerpts retrieved by the Examining Attorney from the NEXIS

database, almost all of which are offered as evidence of the asserted descriptiveness of the phrase "electronic physician"; reprints introduced by applicant of web pages accessible via applicant's web site and which concern applicant and its products and services; web pages introduced by the Examining Attorney which contain articles on the merits, or lack thereof, of protecting "'e' words" as trademarks; and a copy of an unpublished Board decision specifically designated not to be cited as precedent.

Before turning to the arguments that have been presented, we attend to objections applicant has made to the material introduced into the record by the Examining Attorney. Because applicant filed a brief, a supplemental brief following remand, and a reply brief, the various objections were raised at different times, but it is clear that applicant maintains them all.

First, applicant argues that the Examining Attorney did not state that the NEXIS excerpts retrieved from her various searches of the database are "representative samples" and we must, therefore, draw the conclusion that the introduced excerpts were the only relevant ones, in the Examining Attorney's view. Applicant argues, therefore, that the percentage of "hits" is very small and this fact alone is probative of the lack of descriptiveness of both

"ephysician" and "electronic physician." Second, applicant argues that the Examining Attorney did not discuss certain web pages made of record with the Examining Attorney's final refusal and, therefore, we should not consider them because they do not have a proper foundation. Third, applicant argues that the Examining Attorney has not complied with proper Office practice, as set forth in the Trademark Manual of Examining Procedure, governing introduction of material from printed publications and governing introduction of material retrieved from research databases.<sup>2</sup> Based on these arguments, applicant urges us to "deem all of the evidence submitted by the Examining Attorney as inadmissible." In the alternative, applicant argues that, at a minimum, NEXIS excerpts or articles retrieved from the Internet and which are derived from foreign publications or wire services are not relevant and should not be considered. Finally, applicant argues that the Board's prior, unpublished decision should not be considered.

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<sup>2</sup> Though this argument was not articulated in the response to the NEXIS article excerpts introduced by the initial Office Action, we consider it in regard to all evidence that can be characterized as publications, whether derived from NEXIS or the Internet, and regardless of the Office Action by which it was introduced.

We agree with applicant that the Examining Attorney must be presumed to have made the best available NEXIS evidence of record, but we do not agree that the arguably small percentage of the total search results made of record should somehow reflect negatively on this evidence. Searches of the Internet and of research databases, including, for example, the LEXIS database employed by many attorneys, can be cast broadly or narrowly. There is nothing inherently wrong in casting a broad search, unless, perhaps, it is the possible waste of the searcher's time and resources. Under applicant's theory, searches by Examining Attorneys for the most relevant evidence might be undermined if Office policy placed a premium on searches which were narrowly tailored to result in a high percentage of usable excerpts, rather than a thorough search which might happen to retrieve both usable and unusable evidence. Also, such policy might encourage Examining Attorneys to make of record a high percentage of their search results, even though individual excerpts might be of dubious relevance. We see nothing to recommend a policy that encourages either approach. In short, we see nothing wrong with casting a broad search and then carefully reviewing the results to ensure that only the best evidence is made of record. Nonetheless, in circumstances such as these, an

applicant remains free to argue, as the instant applicant has done, that when a small percentage of a search's results are made of record, this may be viewed as probative that a term or terms which otherwise appear in widespread use are not widely used in connection with an applicant's goods or services.

In regard to the web pages made of record with the final refusal, we agree that we can find no discussion of these in the refusal. Accordingly, we have not considered these pages.<sup>3</sup>

As to applicant's argument that the Examining Attorney has not complied with Office practice in her introduction of NEXIS excerpts and articles retrieved from the Internet, we disagree. There is sufficient information to allow applicant to determine the source of these articles. Indeed, applicant has had no difficulty determining which are relevant and which are not (e.g., wire service reports and reports from foreign publications). Also, we believe there is sufficient information of record to allow the

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<sup>3</sup> We observe, however, that exclusion of these items has had little influence on this case. It appears that these materials were introduced either to show that the "e" prefix is equivalent to "electronic" or that there is a proliferation of words featuring an "e" prefix. Applicant, as discussed infra, has expressly conceded the former point and implicitly conceded the latter by virtue of its argument that consumers are accustomed to differentiating between "e" prefixed marks and "e" prefixed descriptive or generic terms.

applicant to discern the Examining Attorney's approach to searching for these articles.

We agree, however, that the various wire service reports and articles from foreign publications are not relevant, and the Board's prior, unpublished decision, cannot be relied on. Accordingly, these have not influenced our decision.

### ***The Arguments***

The elements of the Examining Attorney's argument all are set out in her brief. First, she contends that the "E" prefix means "electronic" and, with or without a following hyphen, would be understood by applicant's customers to indicate the electronic nature of applicant's goods and services. Second, she contends that "physician" also is descriptive, because it designates the intended user or purchaser of applicant's goods or services. The composite EPHYSICIAN is descriptive, according to the argument, because the individual components are; because the combination "does not result in a term so incongruous or unusual" that its only significance could be as identifying mark for the applicant's goods and services; and the composite's primary significance is the same as that of

each of its components, i.e., to reveal "a feature and/or function" of the goods and services.

In regard to perception of the mark by customers, the Examining Attorney contends, there is no need for a prospective customer of applicant to use "imagination, effort, thought or an extra mental step" to understand the import of EPHYSICIAN; rather, it "immediately conveys information regarding the goods and services, namely, that they involve the electronic delivery of information for physicians...."

In regard to the need for any competitor of applicant to use EPHYSICIAN, the Examining Attorney argues that even if applicant is the first or only user of the term, it must still be kept free for others to use as the Internet and use thereof grows; that there is significant use of "electronic physician," a phrase for which EPHYSICIAN is the equivalent; and there is evidence of at least one apparent competitive use, i.e., the use by "MD net guide" on its home page, as described in a NEXIS excerpt from the *Philadelphia Business Journal* of February 11, 2000.

Applicant explains that its goods are "essentially a computer-based patient management system for use by healthcare professionals to better and more accurately treat patients and to keep records related to such

treatments." Brief, p. 2. Applicant concedes that "'E' is frequently used to mean 'electronic' and that certain words with an 'E' prefix have become common, generic terms (e.g. e-mail and e-commerce)." Brief, p. 4. At the oral hearing, applicant's counsel further conceded that both E and PHYSICIAN would, used individually, be descriptive for applicant's goods.<sup>4</sup> Nonetheless, applicant argues, the Examining Attorney has not paid enough attention to the fact that applicant's mark is not E or PHYSICIAN but, rather, is EPHYSICIAN, and that this composite is "more than the sum of its parts" and "requires an analysis of both the effect of the combination on the minds of prospective consumers and the competitive need for others to use that particular combination."

In regard to the "effect of the combination," applicant asserts that "hearing or seeing EPHYSICIAN," a prospective consumer of applicant's goods and services "would not understand what was meant by this term." Response to initial Office Action, p. 4. Moreover, applicant argues, if "ephysician" is taken to mean "electronic physician" then it would describe "a robot, or

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<sup>4</sup> Applicant "could not stop another in the same field from using an E-prefix in its mark, nor could it stop another from using PHYSICIAN for goods or services directed to physicians." Reply brief, p. 6.

at least a device which takes the place of a physician in some fashion (e.g., a diagnostic tool)." But, applicant hastens to add; its goods and services do not involve "robotic doctoring." Applicant asserts the composite EPHYSICIAN is, therefore, incongruous. Brief, p. 5.

In regard to "competitive need," applicant argues in its briefs that it is clear applicant's use of EPHYSICIAN would not inhibit competition; that, if there were a need for competitors to use it, the Examining Attorney would have discovered evidence of its use; that there are only two NEXIS excerpts revealing use of "ephysician" and one of these is inadmissible; and that there are myriad other terms that could be used by offerors of competitive patient management systems. At the oral argument, applicant's counsel asserted that the one admissible NEXIS excerpt showing use of "ephysician," which may appear to be a use by a competitor, in fact "may" be a use referring to applicant or to a client. In addition, counsel asserted that there are other marks being used by competitors of applicant which are "doing better" than applicant.

### ***Decision***

It is, of course, well settled that the question whether a term is merely descriptive is determined not in

the abstract but, rather, in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser or user of the goods or services. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979) and In re Recovery, 196 USPQ 830 (TTAB 1977).

A proposed mark is considered merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately conveys information about an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-218 (CCPA 1978); see also In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985). Thus, it is not necessary, in this instance, that a prospective purchaser of applicant's goods or services be immediately apprised of the full panoply of features of applicant's

goods or services for the term EPHYSICIAN to be found merely descriptive.

Applicant concedes that the prefix "E" means electronic and concedes that it has no exclusive right to use the "E" prefix for its goods and services, which utilize the Internet.<sup>5</sup> Further, applicant concedes that it has no exclusive right to use "physician," because applicant's goods and services are targeted to physicians. Applicant argues, however, that a physician, hearing or seeing the composite EPHYSICIAN would not know what it meant. That, of course, is not the question. Rather, the question is whether a physician, as the targeted prospective purchaser or user of applicant's goods or services, would, when contemplating EPHYSICIAN in conjunction with applicant's Internet-based patient management system and services, immediately derive some descriptive meaning from the use of the term, or would the physician have to cogitate or wonder what significance the term has for such goods and services.

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<sup>5</sup> Even had applicant not conceded this, the record clearly establishes that "E" as a prefix, whether with or without a hyphen, is an accepted shorthand reference for "electronic" and is widely coupled with other terms to indicate that goods or services are provided by, or available via, the Internet. See also, in this regard, In re Styleclick.com Inc., 57 USPQ2d 1445, 1448 (TTAB 2000) ("In sum, 'e-', when used as a prefix in the manner of applicant's mark, has the generally recognized meaning of 'electronic' in terms of computers and the Internet.").

We believe the prospective customer physician would immediately perceive that use of the goods and services would further the physician's effort to be an "electronic physician," i.e., an Internet- or web-savvy physician utilizing the most up to date technology for dealing with patients, pharmacies and laboratories. We agree with applicant that most of the Examining Attorney's NEXIS evidence of use of the phrase "electronic physician" does not show use in this manner. We disagree, however, that the evidence suggests that most individuals, when confronted with the phrase "electronic physician" would unerringly think of "robotic doctors" or diagnostic tools. Quite frankly, most of the NEXIS evidence supports neither the applicant's nor the Examining Attorney's view of this case.<sup>6</sup>

We note, in particular, the following NEXIS references:

HEADLINE: "Doctor Dean" has had practice talking to masses

In a world where psychological counseling has become a radio staple, it seems to follow that

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<sup>6</sup> Most of the NEXIS excerpts do not illustrate use of "electronic physician" as a unitary phrase and are, therefore, of little aid. There are a handful of references that refer to so-called robotic doctors or computers engaged in diagnosing patient conditions; or to an electronics technician as an "electronic physician"; and, as discussed herein, to flesh and blood physicians who have an electronic aspect to their practice.

medical advice should be as close as your television set.

Welcome Dr. Dean Edell, poised to emerge as America['s] latest electronic physician—a man who makes house calls over a living room picture tube via his new NBC weekday series....

--*The Houston Chronicle*, June 28, 1992.

HEADLINE: A dot.com aimed at health care providers

MD net guide's niche is that of a directory that organizes information efficiently for doctors, not a primary source of information.

This makes staffing and expenditures lighter than what other medical Web sites may require, Higgins said.

MD net guide's marketing pitch plays on what may be a physician's handicap when it comes to technology.

"Are you an ePhysician?" MD net guide's home page recently asked. "The use of technology and information to improve patient care is what sets an ePhysician apart from other healthcare professionals." (Read: are you savvy or aren't you?)

And those savvy docs who scroll down the page find they may be eligible to receive one of 10,000 handheld computers which use office management software. The software, among other things, allows doctors to place pharmacy orders electronically, promising to reduce errors associated with illegible handwriting.

The ePhysician image may be one doctors themselves would like to market to their patients. Increasingly, said Higgins, patients are bringing print-outs of Web sites into the exam room.

A doctor who is comfortable with technology can respond to that information or, better yet, provide the patient with links to more information about a specific condition.

--*Philadelphia Business Journal*, February 11, 2000.

The *Houston Chronicle* excerpt suggests that the notion of a technology-empowered physician is not a phenomenon given birth by the advent of the Internet. Instead, it suggests that physicians who used other, more "primitive" forms of electronic technology could be thought of as "electronic physicians." The *Philadelphia Business Journal* excerpt suggests that "ePhysician" is a term that clearly denotes a physician who uses the Internet in his or her practice.

Applicant's counsel asserted, at the oral hearing, that the *Philadelphia Business Journal* article excerpt "may" not be a descriptive use but, instead, a use in reference to applicant. Apart from this contention, which we consider below, applicant also asserts that there simply is not enough evidence of descriptiveness, that "doubt springs from the paucity of evidence," and that such doubt must be resolved in favor of applicant.

The Examining Attorney, however, is correct in her observation that even if applicant is the first or only user of a term, registration must be refused if it is descriptive of applicant's goods or services. See In re Central Sprinkler Co., 49 USPQ2d 1194 (TTAB 1998); In re Eden Foods Inc., 24 USPQ2d 1757, 1761 (TTAB 1992).

Further, the following principle, expressed in the *Styleclick.com* case, is equally applicable here: "As the Internet continues to grow, merely descriptive 'e-' prefix terms for Internet-related goods and/or services must be kept available for competitive use by others." *Styleclick.com*, *supra*, at 1448. Thus, the "paucity" of evidence does not raise doubt about the descriptiveness of the term EPHYSICIAN.

In regard to counsel's claim that the *Philadelphia Business Journal* article may not be in reference to a competitor and, therefore, is not evidence of descriptive use of "ePhysician,"<sup>7</sup> we note that this evidence was introduced with the Examining Attorney's final refusal and was specifically addressed by applicant in its appeal brief. Yet applicant did not raise any claim in its brief that this article did not reference a competitor. Under the circumstances, we cannot discount this evidence solely on the representation of counsel, at the oral hearing, that the use discussed in the excerpt "may" not be that of a

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<sup>7</sup> Applicant has applied to register EPHYSICIAN with a typed drawing of the mark. It appears from applicant's briefing of this appeal that applicant may actually be using the term in the ePhysician form, i.e., with a lower case "e" and capital "P". It does not appear that this latter method of use would necessitate amendment to a special form drawing, but the question is not before us. Our decision would not be affected by any potential change from EPHYSICIAN in typed form to ePhysician in special form, as we believe each would convey the same impression.

competitor. Moreover, even if we assumed that the use of "ePhysician" on the "MD net guide" home page is in the context of a discussion applicant's goods, the method of use is as a descriptive term, and is not proper trademark use. In short, this NEXIS excerpt is evidence of descriptiveness, however it is weighed.

Prospective customer physicians, when contemplating EPHYSICIAN in conjunction with applicant's goods and services, would immediately be apprised of a significant attribute thereof, i.e., that users would be "ephysicians" or "electronic physicians" in the sense of being Internet-savvy physicians. Cf. In re Camel Manufacturing Company, Inc., 222 USPQ 1031 (TTAB 1984) (term refused registration as descriptive when it merely identifies individuals to whom goods or services are directed). We are not persuaded otherwise by applicant's contention that "ephysician" would be taken to mean a "robotic doctor" or other technology-based diagnostic tool. The term may very well be perceived in that manner if contemplated in conjunction with such goods or related services, but that is not the situation before us.

Finally, we are not persuaded by applicant's argument that there are other suitable terms which could be used to describe the type of physician one becomes when using goods

and services such as applicant's; or by applicant's related contention that competitors using other marks are "doing better" than applicant. The argument is unsupported and speculative. Moreover, a descriptive term is not rendered registrable merely because there may be alternative descriptive terms also available for use. Cf. Genesee Brewing Co. v. Stroh Brewing Co., 124 F.3d 137, 149 n.15, 43 USPQ2d 1734, 1743 n.15 (2nd Cir. 1997)(possible alternatives may not be as effective in communicating information to prospective purchasers); and Duraco Products Inc. v. Joy Plastic Enterprises Ltd., 40 F.3d 1431, 1442, 32 USPQ2d 1724, 1732 (3rd Cir. 1994) (difference between generic and descriptive terms is that latter have more, though finite, equivalents; but descriptive terms still protectible only on showing of secondary meaning).

Decision: The refusal of registration is affirmed.